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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,046	02/20/2002	Jim Wells	SUNESIS.2DV1C2	9481

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EXAMINER

EPPERSON, JON D

ART UNIT	PAPER NUMBER
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1627

DATE MAILED: 08/13/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary*File Copy*

Application No.

10/082,046

Applicant(s)

WELLS ET AL.

Examiner

Jon D Epperson

Art Unit

1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 20, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2-63 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1627

DETAILED ACTION

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The fax number is (703) 308-4315. A fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Joseph McKane, Supervisory Patent Examiner, at (703) 308-4537. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

NOTE: The preliminary amendment filed on February 02, 2002 is acknowledged. Claim 1 was cancelled without prejudice and claims 40-63 were added.

Election/Restriction

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 2-13, drawn to a first method for "identifying an organic molecule ligand", variously classified in class 435, subclass 7.1; class 434, DIG 2; class 435, DIG 14; class 435, DIG 14; class 435, DIG 15; class 435, DIG 22; class 435, DIG 34; class 435, DIG 35; class 435, DIG 46.
 - II. Claims 14-31, drawn to a second method for "identifying an organic molecule ligand", variously classified in class 435, subclass 7.1; class 434, DIG 2; class 435, DIG 14; class 435, DIG 14; class 435, DIG 15; class 435, DIG 22; class 435, DIG 34; class 435, DIG 35; class 435, DIG 46.
 - III. Claims 32-39, drawn to a third method for "identifying an organic molecule ligand", variously classified in class 435, subclass 7.1; class 434, DIG 2; class 435, DIG 14; class 435, DIG 14; class 435, DIG 15; class 435, DIG 22; class 435, DIG 34; class 435, DIG 35; class 435, DIG 46.

IV. Claims 40-63, drawn to a fourth method of “identifying an organic molecule ligand”, variously classified in class class 435, subclass 7.1; class 434, DIG 2; class 435, DIG 14; class 435, DIG 14; class 435, DIG 15; class 435, DIG 22; class 435, DIG 34; class 435, DIG 35; class 435, DIG 46.

2. The inventions are distinct, each from the other because of the following reasons:

3. Groups I and II-IV represent patentably distinct methods. The methods are distinct because they use different steps, require different reagents and/or will produce different results. In the instant case, Group I represents a method with no method steps (since claim 1 was deleted by applicant i.e., see preliminary amendment), whereas Groups II-IV represent methods with distinct method steps. As a result, Groups II-IV require different reagents (materials outlined for carrying out their method steps) than Group I because Group I does not require any method steps at all i.e., since claim 1 was deleted in the preliminary amendment without prejudice. Furthermore, Group I will produce different results than Groups II-IV in situations where the method steps of Groups II-IV are required because Group I does not require any method steps. Therefore, Groups I and II-IV have different issues regarding patentability and enablement and represent patentably distinct subject matter.

4. Groups II and III represent patentably distinct methods. The methods are distinct because they use different steps, require different reagents and/or will produce different results. In the instant case, Group III requires “linking said first and second organic molecule ligands through a linker”, which is not a step that is required by the method of Group II. As a result, Groups III

Art Unit: 1627

require different reagents (materials for linking a first and a second organic ligand together) than Group II. Furthermore, Group III will produce different results than Groups II in situations where the materials for linking a first and a second organic ligand together are required. Therefore, Groups II and III have different issues regarding patentability and enablement and represent patentably distinct subject matter.

5. Groups II and IV represent patentably distinct methods. The methods are distinct because they use different steps, require different reagents and/or will produce different results. In the instant case, Group IV requires "obtaining said target protein comprising a -SH group, masked -SH group, or activated -SH group", which is not a method step that is required by the method of Group II. As a result, Groups IV requires different reagents (target protein comprising a -SH group, masked -SH group, or activated -SH group) than Group II. Furthermore, Group IV will produce different results than Groups II in situations where a target protein comprising a -SH group, masked -SH group, or activated -SH group are required. Therefore, Groups II and IV have different issues regarding patentability and enablement and represent patentably distinct subject matter.

6. Groups III and IV represent patentably distinct methods. The methods are distinct because they use different steps, require different reagents and/or will produce different results. In the instant case, Group IV requires "obtaining said target protein comprising a -SH group, masked -SH group, or activated -SH group", which is not a method step that is required by the method of Group III. As a result, Groups IV requires different reagents (target protein

Art Unit: 1627

comprising a -SH group, masked -SH group, or activated -SH group) than Group III.

Furthermore, Group IV will produce different results than Groups III in situations where a target protein comprising a -SH group, masked -SH group, or activated -SH group are required.

Furthermore, Group III requires "linking said first and second organic molecule ligands through a linker", which is not a step that is required by the method of Group IV. As a result, Groups III require different reagents (materials for linking a first and a second organic ligand together) than Group IV. Furthermore, Group III will produce different results than Groups IV in situations where the materials for linking a first and a second organic ligand together are required.

Therefore, Groups III and IV have different issues regarding patentability and enablement and represent patentably distinct subject matter.

7. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. The different methods and products would require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

8. This application contains claims directed to patentably distinct species of the claimed invention for Groups I-IV. Election is required as follows.

9. If applicant elects the invention of Group I, applicant is required to elect from the following patentably distinct species.

Art Unit: 1627

Subgroup 1: Species of biological target molecule (see claim 2)

- A. Polypeptide***
- B. Nucleic acid
- C. Carbohydrate
- D. Nucleoprotein
- E. Glycopeptide
- F. Glycolipid
- G. Lipoprotein

***Note: If applicant elects group A from above in subgroup 1, applicant is also required to elect a specific polypeptide from subgroup 2 below i.e., applicant does not have to elect a species from subgroup 2 below if they do not elect a polypeptide from subgroup 1 above. Furthermore, applicant must disclose which claims read only on subgroup 1 or subgroup 2 (only if applicant elects a polypeptide from subgroup 1 above).

Subgroup 2: Species of polypeptide (see claim 4)

- A. Enzyme
- B. Hormone
- C. Transcription factor
- D. Receptor
- F. Ligand for a receptor
- G. Growth factor
- H. Immunoglobulin

Subgroup 3: Species of modification (see claims 5-6)

- A. Biological target molecule comprises said chemically reactive group without prior modification of said target molecule.
- B. Biological target molecule comprises said chemically reactive group with prior modification of said target molecule.

Subgroup 4: Species of modification (see claims 5-7)

Applicant must elect for the purposes of search, a single species of "chemically reactive group" wherein a specific structure is set forth, which clearly shows all of the atoms and bonds that are necessary to define the chemically reactive group. Applicant should not use notations like X or R when identifying the elected structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must disclose which claims read on the species of modification i.e., which claims read only on subgroup 4.

Subgroup 5: Species of library (see claim 8)

Applicant is required to elect, for purposes of a search, a single specific library of compounds. The election should result in a particularly defined core structure that is shared by all library members. In defining this core structure, all variable

groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a representative example of the library must be elected. Furthermore, applicant should not use notations like R or X when identifying the elected representative example structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 5.

Subgroup 6: Species of identifying organic compound (see claims 11-12)

Applicant must elect for the purposes of search, a single species of "identifying organic compound" e.g., mass spectroscopy, NMR, capillary electrophoresis. Furthermore, applicant must disclose which claims read on the species of identifying organic compound i.e., which claims read only on the elect species of subgroup 6.

Subgroup 7: Species of target molecule/organic compound conjugate (see claim 12)

Applicant is required to elect, for purposes of a search, a single specific target molecule/organic compound conjugate of compounds. The election should result in a particularly defined structure, which clearly shows all of the atoms and bonds that are necessary to define the target molecule/organic compound conjugate structure. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 7.

Subgroup 8: Species of library of organic molecules (see claim 13)

Applicant is required to elect, for purposes of a search, a single specific library of organic molecules of compounds. The election should result in a particularly defined core structure that is shared by all library of organic molecules members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a representative example of the library of organic molecules must be elected. Furthermore, applicant should not use notations like R or X when identifying the elected representative example structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 8.

10. If applicant elects the invention of Group II, applicant is required to elect from the following patentably distinct species.

Art Unit: 1627

Subgroup 9: Species of biological target molecule with first reactive functionality (see claims 14 and 18-20)

- A. Polypeptide***
- B. Nucleic acid
- C. Carbohydrate
- D. Nucleoprotein
- E. Glycopeptide
- F. Glycolipid
- G. Lipoprotein

***Note: If applicant elects group A from above in subgroup 9, applicant is also required to elect a specific polypeptide from subgroup 10 below i.e., applicant does not have to elect a species from subgroup 10 below if they do not elect a polypeptide from subgroup 9 above. Furthermore, applicant must disclose which claims read only on subgroup 9 or subgroup 10 (only if applicant elects a polypeptide from subgroup 9 above).

***Note: If applicant elects group A from above in subgroup 11, applicant must also elect a species of polypeptide formation i.e., applicant must pick only one of the following species: recombinant expression product or synthetically derived. (see claims 22 and 23)

Subgroup 10: Species of polypeptide (see claim 20)

- A. Enzyme
- B. Hormone
- C. Transcription factor
- D. Receptor
- F. Ligand for a receptor
- G. Growth factor
- H. Immunoglobulin

Subgroup 11: Species of biological target molecule with second reactive functionality (see claims 14 and 18-20)

- A. Polypeptide***
- B. Nucleic acid
- C. Carbohydrate
- D. Nucleoprotein
- E. Glycopeptide
- F. Glycolipid
- G. Lipoprotein

***Note: If applicant elects group A from above in subgroup 11, applicant is also required to elect a specific polypeptide from subgroup 12 below i.e., applicant does not have to elect a species from subgroup 12 below if they do not elect a polypeptide from

Art Unit: 1627

subgroup 11 above. Furthermore, applicant must disclose which claims read only on subgroup 11 or subgroup 12 (only if applicant elects a polypeptide from subgroup 11 above).

***Note: If applicant elects group A from above in subgroup 11, applicant must also elect a species of polypeptide formation i.e., applicant must pick only one of the following species: recombinant expression product or synthetically derived. (see claims 22 and 23)

Subgroup 12: Species of polypeptide (see claim 20)

- A. Enzyme
- B. Hormone
- C. Transcription factor
- D. Receptor
- F. Ligand for a receptor
- G. Growth factor
- H. Immunoglobulin

Subgroup 13: Species of first reactive functionality (see claim 14)

Applicant must elect, for the purposes of search, a single species corresponding to the "first reactive functionality" wherein a specific structure is set forth, which clearly shows all of the atoms and bonds that are necessary to define the first reactive functionality. Applicant should not use notations like X or R when identifying the elected structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 13.

Subgroup 14: Species of second reactive functionality (see claim 14)

Applicant must elect, for the purposes of search, a single species corresponding to the "second reactive functionality" wherein a specific structure is set forth, which clearly shows all of the atoms and bonds that are necessary to define the second reactive functionality. Applicant should not use notations like X or R when identifying the elected structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 14.

Subgroup 15: Species of target molecule/organic compound conjugate (see claim 14)

Applicant is required to elect, for purposes of a search, a single specific target molecule/organic compound conjugate of compounds. The election should result in a particularly defined structure, which clearly shows all of the atoms and bonds that are necessary to define the target molecule/organic compound conjugate structure. Furthermore, applicant must indicate which claims read on

Art Unit: 1627

the elected species i.e., which claims read only on the elected species of subgroup 15.

Subgroup 16: Species of identifying organic compound (see claims 14)

Applicant must elect for the purposes of search, a single species of "identifying organic compound" e.g., mass spectroscopy, NMR, capillary electrophoresis. Furthermore, applicant must disclose which claims read on the species of identifying organic compound i.e., which claims read only on the elect species of subgroup 16.

Subgroup 17: Species of library (see claim 4)

Applicant is required to elect, for purposes of a search, a single specific library of compounds. The election should result in a particularly defined core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a representative example of the library must be elected. Furthermore, applicant should not use notations like R or X when identifying the elected representative example structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 17.

Subgroup 18: Species of method (see claims 14, 15-17, 28-30)

- A. Method of claim 14
- B. Method of claims 15-16^{*1*}
- C. Method of claims 28-29^{*2*}

^{*1*} Note: If applicant elects group B from above in subgroup 18, applicant is also required to elect a single species of "agent that disrupts disulfide bonds" i.e., elect only one from the following group: dithiothreitol, dithioreythritol, β -mercaptoethanol, sodium borohydride or phosphine (see claim 17).

^{*2*} Note: If applicant elects group C from above in subgroup 18, applicant is also required to elect a single species of "reducing agent" i.e., elect only one from the following group: sodium cyanoborohydride, sodium triacetoxymorohydride and cyanide (see claim 30).

11. If applicant elects the invention of Group III, applicant is required to elect from the following patentably distinct species.

Art Unit: 1627

Subgroup 19: Species of biological target molecule (see claims 32-34)

- A. Polypeptide***
- B. Nucleic acid
- C. Carbohydrate
- D. Nucleoprotein
- E. Glycopeptide
- F. Glycolipid
- G. Lipoprotein

***Note: If applicant elects group A from above in subgroup 19, applicant is also required to elect a specific polypeptide from subgroup 20 below i.e., applicant does not have to elect a species from subgroup 20 below if they do not elect a polypeptide from subgroup 19 above. Furthermore, applicant must disclose which claims read only on subgroup 19 or subgroup 20 (only if applicant elects a polypeptide from subgroup 19 above).

Subgroup 20: Species of polypeptide (see claim 32)

Applicant must elect, for purposes of search a single specific species of polypeptide (e.g., enzyme, hormone, transcription factor, etc.). Furthermore, applicant must indicate which claims read on the single elected species i.e., which claims read only on subgroup 20.

Subgroup 21: Species of first organic molecule ligand (see claim 32)

Applicant must elect, for the purposes of search, a single species corresponding to the "first organic molecule ligand" wherein a specific structure is set forth, which clearly shows all of the atoms and bonds that are necessary to define the first organic molecule ligand. Applicant should not use notations like X or R when identifying the elected structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 21.

Subgroup 22: Species of second organic molecule ligand (see claim 32)

Applicant must elect, for the purposes of search, a single species corresponding to the "second organic molecule ligand" wherein a specific structure is set forth, which clearly shows all of the atoms and bonds that are necessary to define the second organic molecule ligand. Applicant should not use notations like X or R when identifying the elected structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 22.

Art Unit: 1627

Subgroup 23: Species of linker (see claim 32)

Applicant must elect, for the purposes of search, a single species corresponding to the “linker” wherein a specific structure is set forth, which clearly shows all of the atoms and bonds that are necessary to define the linker. Applicant should not use notations like X or R when identifying the elected structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 23.

Subgroup 24: Species of conjugate molecule (see claim 32)

Applicant must elect, for the purposes of search, a single species corresponding to the “conjugate molecule” wherein a specific structure is set forth, which clearly shows all of the atoms and bonds that are necessary to define the conjugate molecule. Applicant should not use notations like X or R when identifying the elected structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 24.

12. If applicant elects the invention of Group IV, applicant is required to elect from the following patentably distinct species.

Subgroup 25: Species of -SH group (see claim 40)

- A. -SH
- B. Masked -SH
- C. Activated -SH

Note: Applicant must also disclose which claims read on the elected species above i.e., which claims read only on subgroup 25.

Subgroup 26: Species of target protein (see claim 40)

Applicant must elect, for purposes of search a single specific species of target protein (e.g., enzyme, hormone, transcription factor, etc.). Furthermore, applicant must indicate which claims read on the single elected species i.e., which claims read only on subgroup 26.

Subgroup 27: Species of ligand candidate (see claim 40)

Applicant must elect, for the purposes of search, a single species corresponding to the “ligand candidate” wherein a specific structure is set forth, which clearly shows all of the atoms and bonds that are necessary to define the ligand candidate.

Art Unit: 1627

Applicant should not use notations like X or R when identifying the elected structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. In addition, applicant must disclose the size of the ligand e.g., 1500 daltons, 1000 daltons, 750 daltons, 500 daltons, etc. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 27.

Subgroup 28: Species of detecting the formation of said target protein-ligand conjugate and identifying the ligand present in said conjugate (see claim 40)

Applicant must elect for the purposes of search, a single species of “identifying organic compound” e.g., mass spectroscopy, NMR, capillary electrophoresis, X-Ray, HPLC, etc. Furthermore, applicant must disclose which claims read on the species of identifying organic compound i.e., which claims read only on the elected species of subgroup 28.

Subgroup 29: Species of method (see claims 40, 46 and 59)

- A. Method of claim 40
- B. Method of claim 46^{*1*}
- C. Method of claims 59-60^{*2*}
- D. Method of claims 61-63^{*3*}

^{*1*} Note: If applicant elects group B from above in subgroup 29, applicant is also required to elect a single species of “reducing agent” e.g., 2-mercaptoetanol.

^{*2*} Note: If applicant elects group C from above in subgroup 29, applicant is also required to elect a single species of “separating the target protein-ligand conjugate from the mixture” (see claim 59).

^{*3*} Note: If applicant elects group D from above in subgroup 29, applicant is also required to elect a single species of “probe” (see claim 59). Furthermore, applicant must elect, for the purposes of search, a specific structure for the probe, which clearly shows all of the atoms and bonds that are necessary to define the probe. Applicant should not use notations like X or R when identifying the elected structure because these letters represent groups with variable members and, as a result, more than one species would be erroneously elected. Furthermore, applicant must indicate which claims read on the elected species i.e., which claims read only on the elected species of subgroup 29.

13. The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. For different species of method, the method steps for each species would differ.

Art Unit: 1627

Moreover, the above species can be separately classified. Consequently, the species have different issues regarding patentability and represent patentably distinct subject matter.

Therefore, this does create an undue search burden, and election for examination purposes as indicated is proper.

14. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

15. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

16. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

17. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

Art Unit: 1627

be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

18. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.43). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

19. Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

20. Applicant is also reminded that a 1 – month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an “action on the merits” for purposes of the second action final program, see MPEP 809.02(a).

Conclusion

Art Unit: 1627

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (703) 308-2423. The examiner can normally be reached Monday through Friday from 8:30 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2439.

Jon D. Epperson, Ph.D.
August 10, 2002


PADMASHRI PONNALURI
PRIMARY EXAMINER